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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,622	02/24/2004	Kazumasa Inoue	TKMTP127	2045
22434	7590	10/27/2006	EXAMINER	
BEYER WEAVER & THOMAS, LLP			CHEUNG, WILLIAM K	
P.O. BOX 70250			ART UNIT	
OAKLAND, CA 94612-0250			PAPER NUMBER	

1713

DATE MAILED: 10/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/786,622

**Applicant(s)**

INOUE ET AL.

**Examiner**

William K. Cheung

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 September 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1, 10 and 12-17 is/are pending in the application.
- 4a) Of the above claim(s) 12-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- \* 1. ☒ Certified copies of the priority documents have been received.
  - 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Request for Continued Examination***

1. The request filed on September 6, 2006 for a Request for Continued Examination (RCE) under 37 CFR 1.53(d) based on parent Application No. 10/786,622 is acceptable and a RCE has been established. An action on the RCE follows. Claims 1, 10, 12-17 are pending. Claims 12-17 are drawn to non-elected subject matter. Claims 1, 10 are examined with merit.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 1, 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kerkar et al. (US patent 5,604,273) in view of Ohta et al. (US Patent 5,660,626), further in view of Berke et al. (US Patent 5,571,319), and yet, still further in view of Kloetzer et al. (US Patent 4,927,463) for the reasons adequately set forth from paragraph 4 of the office action of June 19, 2006.

Applicant's arguments filed September 6, 2006 have been fully considered but they are not persuasive. After making the amendment of September 6, 2006, applicants argue that since Berke et al. do not disclose a compound having the Formula 3 as claimed. However, the examiner disagrees because Ohta et al. (col. 9, line 25-29) clearly disclose the use of diethylene glycol dipropylene glycol monobutyl ether (which meet applicants' Formula 3) as drying shrinkage reducing agent. Motivated by the expectation of success of using diethylene glycol dipropylene glycol monobutyl ether for reducing shrinkage, it would have been obvious to one of ordinary skill in art to incorporate the diethylene glycol dipropylene glycol monobutyl ether teachings of Ohta et al. into the composition teachings of Kerkar et al. to obtain the invention of claims 1, 10.

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4. Claims 1, 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kerkar et al. (US patent 5,604,273) in view of Ohta et al. (US Patent 5,660,626), further in view of Kloetzer et al. (US Patent 4,927,463) for the reasons adequately set forth from paragraph 4 of the office action of June 19, 2006.

The paragraph 4 is essentially identical to paragraph 3 of instant office action, except that the reference to Berke et al. (US Patent 5,571,319) has been removed, since the instant rejection does not require any teachings from the reference Berke et al. (US Patent 5,571,319) for the rejection of claims 1, 10.

Applicant's arguments filed September 6, 2006 have been fully considered but they are not persuasive. After making the amendment of September 6, 2006, applicants argue that since Berke et al. do not disclose a compound having the Formula 3 as claimed. However, the examiner disagrees because Ohta et al. (col. 9, line 25-29) clearly disclose the use of diethylene glycol dipropylene glycol monobutyl ether (which meet applicants' Formula 3) as drying shrinkage reducing agent. Motivated by the expectation of success of using diethylene glycol dipropylene glycol monobutyl ether for reducing shrinkage, it would have been obvious to one of ordinary skill in art to incorporate the diethylene glycol dipropylene glycol monobutyl ether teachings of Ohta et al. into the composition teachings of Kerkar et al. to obtain the invention of claims 1, 10.

***Priority***

5. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on March 3, 2003. It is noted, however, that applicant has not filed a certified copy of the 2003-55175 application as required by 35 U.S.C. 119(b).

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William K. Cheung whose telephone number is (571) 272-1097. The examiner can normally be reached on Monday-Friday 9:00AM to 2:00PM; 4:00PM to 8:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David WU can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



William K. Cheung, Ph. D.

Primary Examiner

October 24, 2006

**WILLIAM K. CHEUNG  
PRIMARY EXAMINER**